

Remarks/Arguments

In the Office Action, dated October 26, 2004, the Examiner affirmed the restriction requirement in the previous Office Action and withdrew claims 6-13 and 15 from further consideration. Although not acknowledged by the Examiner in this Office Action, claims 5 and 9 were actually cancelled in the previous Office Action, so it is apparently only claims 1-4, 14, and 16 that are currently under consideration, and claims 6-8, 10-13, and 15 are apparently withdrawn from consideration.

The Examiner repeated his previous rejection of claims 1-10 under the judicially created doctrine of obviousness-type double patenting. Since claims 5 and 9 were cancelled by the Applicant in response to the previous Office Action and claim 10 is now withdrawn by the Examiner from further consideration, as mentioned above, and, further, since the terminal disclaimer submitted previously (as part of the "Amendment Under 37 CFR 1.111" dated 3/29/04) obviates this double patenting rejection, Applicant believes the Examiner might have inadvertently repeated this obviousness-type double patenting rejection. If applicant is wrong in this regard, the Examiner is requested to let the Applicant know so that the issue can be addressed further.

The Examiner rejected claims 1-5, 14, and 16 under 35 U.S.C. §103(a) as being unpatentable over Hill (U.S. 5,678,793) in view of Ray (U.S. 3,956,600). Since claim 5 was previously cancelled, as noted above, the Applicant believes the Examiner might have intended this rejection under 35 U.S.C. §103(a) to apply to claims 1-4, 14, and 16. If Applicant is mistaken in this regard the Examiner is requested to let the Applicant know.

The Applicant appreciates Examiner Chiang's courtesy in discussing the rejected claims 1, 14, and 16 with the Applicant's attorney by telephone on February 8, 2005. While no agreement was reached, the Applicant believes the discussion was beneficial and did advance the prosecution. The Examiner initially questioned why Applicant was pursuing this continuation application in view of the Applicant having already obtained U.S. Patent No. 6,246,766. Therefore, the discussion proceeded by focusing the Examiner's attention to the fact that the claims in the parent patent application (now issued U.S. Patent No. 6,246,766) are limited by the cup holder base 20, whereas the present continuation

application is directed to the concave recess 42 in the underside 40 of the shelf 30 for guiding the belt clip C, thus the telephone T as well, to the center of shelf 30 as the telephone T is being mounted with its belt clip C on the shelf 30. Essentially, the examiner concurred that an amendment with a more explicit recitation in claim 1, 14, and 16 of Applicant's concave surface 42 being in the underside (bottom) 40 of Applicant's shelf 30 would distinguish Applicant's invention over the newly cited Ray reference. However, the Examiner also observed that such an amendment would merit additional consideration and possibly additional searching, which would require the filing of a Request for Continuing Examination (RCE). Therefore, this Amendment adds that recitation to claims 1, 14, and 16, and is accompanied by an RCE.

This novel, concave recess 42 in the underside of the shelf 30 is an important feature for a cell phone holder, because it helps a user to get the cell phone positioned on the center of the shelf 30 without unnecessary distraction from the user's other obligations, such as keeping his/her eyes on the road while driving. The recess 42 not only helps to spread the belt clip C, but its concavity also helps to guide the belt clip C, thus also the cell phone T, to the midportion of the shelf 30, which is not obvious. Keeping unnecessary distractions to a minimum is important, not only while talking on cell phones, but also while stowing them. The concavity of the recess 42 in the bottom or underside 40 facilitates centering the belt clip C, thus telephone T, on the shelf 30 in a smooth, mounting motion without having to look at it and without having to think about it.

The Ray telephone caddy is inapposite to this feature and to this function. First, there is no belt clip on the handset 2 of Ray's telephone. Second, there is no concave recess in the underside of Ray's telephone caddy. Third, the very structure of the Ray telephone caddy and the natural motion imposed by that structure for mounting the handset 2 on the caddy requires that the lower end of Ray's handset 2 be guided into the cradle 3 first. Therefore, the guiding and centering function of Ray is provided by the cradle 3 on the front side of the caddy, and the concavity at the top of the Ray caddy is apparently only an incidental, ornamental configuration.

Ray does not describe any function whatsoever for the incidental, ornamental concavity on the front surface of this caddy. "**Elements of separate prior art patents**

cannot be combined when there is no suggestion of that combination anywhere in those patents.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987); *ACS Hospital Systems, Inc. v. Montefiori Hospital*, 732 F.2d 1577, 1572, 221 USPQ 929, 933 (Fed. Cir. 1984). There is nothing in any of the description in Ray that could be construed as ascribing any functional significance to the concave appearance of the upper end of Ray’s caddy, and there is certainly no incentive or suggestion in Ray to put the concavity in the top surface of Ray into the underside of Hill, let alone to use such a concavity to interact with a belt clip to center a cell phone.

Further, for 35 U.S.C. 103 obviousness determinations, “**a prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention . . .”** *Panduit Corp. v. Dennison Mfg. Co.*, *supra*; *W.L. Gore & Associates v. Garlock, Inc.*, 72132 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In this case, Ray teaches that the cradle 3 positions and holds the handset 2 on his caddy, and he says nothing about any such function for the ornamental configuration, so Ray actually leads away from the Applicant’s concave recess 42. therefore, only hindsight, using Applicant’s own invention as a guide, would lead one to even look at Ray’s ornamental concave shape, let alone apply that reference in a 35 U.S.C. 103 rejection of Applicant’s claims 1, 14, and 16. However, use of hindsight by the Examiner, i.e., using the applicant’s own claims as a guide to make the modifications needed in the prior art to get the applicant’s invention, is strictly prohibited. (See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312). Therefore, the independent claims 1, 14, and 16, as amended to recite the concavity in the underside of the shelf of the present invention, is clearly non-obvious and allowable under 35 U.S.C. 103(a).

The dependent claims 2-4 also recite features that are not shown in the prior art in addition to the features of independent claim 1. Therefore, the dependent claims 2-4 are also allowable.

In summary, all of the claims 1-4, 14, and 16 are believed to be allowable for the reasons explained above. Therefore, the Examiner is requested to reconsider the previous rejections of those claims and to grant an early allowance. If there are any remaining issues to be resolved, the Examiner is requested to contact applicant's attorney at the telephone number listed below.

Respectfully Submitted,
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Date: March 28, 2005